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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,567	12/22/2003	Ian Boddy	71486-0065	1566
20915	7590	03/09/2006	EXAMINER	
MCGARRY BAIR PC 171 MONROE AVENUE, N.W. SUITE 600 GRAND RAPIDS, MI 49503			SHAFFER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

Office Action Summary	Application No. 10/707,567	Applicant(s) BODDY ET AL.	
	Examiner Ricky D. Shafer	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 and 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of invention I (claims 2-14) and species "A", depicted by Fig. 9, in the reply filed on 01/17/2006 is acknowledged. The traversal filed is on the ground(s) that the statutory basis for a proper restriction requires two or more independent and distinct inventions. This is not found persuasive because "The law has long been established that dependent inventions...may be properly divided if they are in fact, "distinct" inventions, even though dependent" (see **MPEP 802.01**) and the criteria for a proper requirement for restriction between patentably distinct inventions is (1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the examiner. Note: **MPEP 803**.

The restriction requirement as set forth in the communication mailed on 06/29/2005, clearly demonstrates the distinctness and burden between each of the patentably distinct inventions. For example, U.S. Patent 3,978,735 clearly evidences that an actuator does not have to have a ball and/or socket joint. In addition, invention I would further require a search in class 248, subclass 481, which would not be required for invention II. Continued search and examination of claims to a non-elected invention/species including claims having substantially different structural limitations is a prima facie showing of burden. Applicant may avoid restriction by presenting an allowable linking claim or by a clear admission on the record that the non-elected invention/species is not patentably distinct from the elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-11 and 15-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/17/2006.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-8 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the tilt of the reflective element" in line 4. There is insufficient antecedent basis for this limitation in the claim.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Replay et al ('735).

Replay et al discloses a vehicular mirror system comprising a reflective element (24) having a mounting portion (25) thereon; an actuator (35,36) operably interconnected to the reflective element for tilting of the reflective element, wherein the actuator is operable in a normal range of travel; and a clutch (46,47) associated with the actuator for operation of the actuator in a first mode and a second mode, wherein in the first mode the actuator moves in a normal mode of operation and actuates the tilt of the reflective element, and wherein in the second mode the actuator is placed in an impeded mode of operation and the clutch allows the actuator to slip and prevent damage thereto (see column 10, lines 18-33). Note figures 1-14 along with the associated description thereof.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharp ('116).

Sharp discloses a vehicular mirror system comprising a reflective element (16) having a mounting portion (18) thereon; an actuator (38) operably interconnected to the reflective element for tilting of the reflective element, wherein the actuator is operable in a normal range of travel; and a clutch (70,102) associated with the actuator for operation of the actuator in a first mode and a second mode, wherein in the first mode the actuator moves in a normal mode of operation and actuates the tilt of the reflective element, and wherein in the second mode the actuator is placed in an impeded mode of operation and the clutch allows the actuator to slip and prevent damage thereto (see column 1, line 54 to column 2, line 21 and column 5, lines 26-58), wherein one of the mounting portion and the actuator comprises a socket (46), and the other of the mounting portion and the actuator comprises a ball (42) and wherein the ball is inherently snap-fit within the socket. Note figures 1-5 and 7-10 along with the associated description thereof.

8. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson ('232).

Thompson discloses a vehicular mirror system which inherently includes a reflective element having a mounting portion thereon (see column 3, lines 47-53) comprising an actuator (12) operably interconnected to the reflective element for tilting of the reflective element, wherein the actuator is operable in a normal range of travel; and a clutch (38-40) associated with the actuator for operation of the actuator in a first mode and a second mode, wherein in the first mode the actuator moves in a normal mode of operation and actuates the tilt of the reflective element, and wherein in the second mode the actuator is placed in an impeded mode of operation and the clutch allows the actuator to slip and prevent damage thereto (see column 4, lines 5-65), wherein one of the mounting portion and the actuator comprises a socket (not shown), and the other of the mounting portion and the actuator comprises a ball (30), wherein the ball is

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inherently snap-fit within the socket , wherein the ball is non-rotatably mounted within the socket (see column 3, lines 47-53), wherein the ball comprises at least one projection (32), and wherein the socket comprises at least one slot in register with the at least one projection and wherein the at least one projection is received within the at least one slot when the ball is received within the socket (see column 3, lines 49-53). Note figures 1-5 along with the associated description thereof.

9. Claims 7, 8 and 12-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The drawings are objected to because element 84, shown in Fig. 12, does not properly point to the compression spring, element 128, shown in Fig. 16, fails to include a lead line, and element 132, shown in Fig. 16, does not properly point to the spring channel. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

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1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference numeral 174, shown in Fig. 18, lacks a proper written description. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

03/04/2006


RICKY D. SHAFER
PATENT EXAMINER
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